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PC-930**REMARKS/ARGUMENTS**

Favorable consideration of this application is respectfully requested. Applicant has rewritten claims 1, 2, 6-9, 12-14, 16, 23 ,24 and 30-31 and added new claims 30-35. Favorable reconsideration of this application is, consequently, earnestly solicited in view of the following remarks.

Claims 1, 2, 6-9, 12-14 and 16 were rejected under sec. 112, first paragraph as objecting to the terms "...infrared or separate radio frequency transmission...." Applicant has canceled the terms "infrared or separate radio frequency transmission." Applicant notes that the specification is clearly enabling for solely using "...wireless telephone lines" as the communication medium for accessing the world wide web as described in the specification and in the former claims. Thus, removal of this rejection is now respectfully requested.

Claims 1, 2, 6-9, 12-14, 16 and 23 were rejected under sec. 112, first paragraph as objecting to the term "conventional." Applicant has now canceled the term "conventional" throughout these claims. Thus, removal of this rejection is now respectfully requested.

Claims 1, 2, 7-9, 12-14 and 23 were rejected under sec. 103 as being obvious over Showghi '739 in view of Pentel '750.

Again, the Showghi reference is based on a PCT application filed in April 27, 2000, which is AFTER the provisional application for the subject invention was applied for in January 6, 2000. Showghi relies on a provisional application that was filed for on April 27, 1999. However, applicant has pulled and includes a copy of the Showghi provisional application and notes that MANY of the features relied upon by the Examiner do not have a priority date back to the provisional application for Showghi.

For example, Independent claims 1, 23, and 24 require "a customer owned personal handheld display device" so that a "customer" uses their own "cell phone, pager or personal digital assistant. Showghi requires attendees at "sporting events, concerts and other gatherings of patrons...in a ...confined facility having seating in identifiable seats...." Page 1 of the Showghi provisional application.

The Showghi provisional application continuously describes and requires their "remote ordering terminals" be used within a "confined facility" and furthermore clearly

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requires a feature of "audibly reminding customers to return the terminals to prevent inadvertent removal of the terminals from the facility", pages 4, 7 of the Showghi provisional application.

Showghi clearly describes that their "remote ordering terminals" are NOT a "cellular phone or pager." Pages 3, 4, and 7 of the Showghi provisional application requires docking stations that must receive the Showghi "terminals" after use so that they can be recharged. Additionally, page 9 of Showghi states that "As a special service to those customers attending large events, which do not have a cellular phone or pager and want to be accessible to external messages, a remote ordering system could be enabled to receive written messages...." Clearly, Showghi does NOT DESCRIBE, TEACH OR SUGGEST the novel use and application of "a customer owned personal handheld display device" as claimed in the subject invention.

Showghi further requires the use of "infrared or radio transmission" for the remote ordering by requiring 'patrons/customers' use the confined facilities owned "remote ordering terminals", owned or controlled within the confined facilities, where these "terminals" MUST BE RETURNED to the facilities after use, pages 4, 6 of the Showghi provisional application.

These requirements in the Showghi provisional application are totally opposite to the claimed features of the subject application.

The subject independent claims which are supported by a provisional application FILED BEFORE SHOWGHI requires the "a customer owned personal handheld display device" is selected from "a pager, a cell phone, and a PDA(personal digital assistant)" that "solely" uses a "existing wireless telephone lines" to dial into a remote website that is remotely located from the "customer owned personal handheld display device." See for example, pages 3 and 4 of the provisional application filed by the subject inventors.

There are other differences between the subject invention and Showghi as well. For example, independent claim 1 of the subject invention requires "the second subcategory headings being solely listed in a single vertical column on the third menu page with separate second subcategory headings solely on each line; third selecting and viewing at least one of the second subcategory headings by scrolling down the single vertical column on the third menu page on the handheld display device; and repeating

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accessing and selecting and viewing by solely scrolling down only one single vertical column on each successive menu page on the handheld display device, until the user reaches an end of a menu series to a finite selection list of a classification that is listed in a single vertical column, wherein interaction of the accessing of the first page, the second page, the third page, and the first selecting, the second selecting and the third selecting are navigated on the handheld display device without inputting any search queries; and viewing the single column of the finite selection list of the classification by scrolling down the finite selection list on the handheld display device, without the inputting of any search queries." These features are similarly claimed in subject claims 8, 23 and 24. As noted previously, these features are also supported by the original provisional application on at least Figures 6-9, filed by the subject inventors.

Showghi clearly shows their display requires plural parallel columns of displays in Figures 3 and 4 of their provisional patent application, and NOT the "single column" formats as claimed in the subject invention.

Still furthermore, Showghi is restricted to selling "Menu items....can comprise the usual items of food, drink souvenir merchandise, but can also include tickets to future events, and services such as restaurant, lodging and transportation services....", column 7, lines 34+. Clearly, Showghi is concerned with selling items to "patrons at large-scale spectator events..." abstract, where the patron is being sold limited items only to persons physically attending those particular events. Showghi does not describe, teach or suggest having a "remote website" where "different advertisements" are placed by "different sellers" that are unrelated to one another, which is now more clearly set forth in the claims. Clearly, Showghi requires their menu items be clearly related to the "event" where the "patrons" are at in attendance, and NOT to different sellers for different advertisements.

Applicant respectfully disagrees with the examiner's statements that Showghi describes the features of the subject dependent claims. For example, subject claim 7 Claims "...wherein the category headings include different types of vehicles, and the first subcategory headings when selecting anyone of the different types of vehicles includes headings for: makes, items, and services", which is clearly supported by the subject specification in reference to figures 5-7 and 17-18. Applicant notes that Fig. 4 of

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Showghi refers to "sandwiches...snacks....souvenirs....Coca-Cola", etc. which are FOOD AND BEVERAGE ITEMS. Clearly, there is NO description, teaching or suggestion for a "subcategory" that breaks down "makes, items, and services" for "different types of vehicles."

The examiner already admits that Showghi does not describe, teach or suggest the claimed features of former claims 6, 16 and 24.

Applicant has amended all the independent claims 1, 23 and 24 to reference the "remote website" that lists "different advertisements from different sellers." In addition claim 13 has been amended to claiming "listed advertisements of different goods by different sellers, and listed advertisements of different services by different sellers....", claim 14 has been amended to "requesting an unlisted item from the web based system by a separate buyer-user, the unlisted item being selected from one of: a selected good and a selected service", claim 24 has further been amended to include the "subcategory" having headers of "goods and services." New claim 30 "includes both: listed advertisements of different goods by different sellers, and listed advertisements of different services by different sellers."

New claim 31 claims "requesting an unlisted item from the web based system by a separate buyer-user, the unlisted item being selected from: a selected good and a selected service; and instantly notifying the separate buyer-user through the customer owned handheld display device, when the unlisted item has been placed by a seller-user to the web based system, which matches the unlisted item; and allowing the buyer-user to purchase the unlisted item from the seller-user."

New claims 32 and 34 claim "the category headings include different types of vehicles and equipment, and the subcategory includes: makes, items and services."

New claims 33 and 35 claim "the different types of vehicles are selected from at least one of: automobiles and trucks and aircraft and boats, and the different types of equipment are selected from at least one of: industrial equipment and agricultural equipment and medical equipment." Clearly, these novel claimed features in the other claims listed above are not described, taught or suggested by the Showghi reference.

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Pentel '750 does not overcome the deficiencies to Showghi described above.

Pentel '750 describes a "remote ordering device", title, and describes "users can remotely order tickets, meals, services or control machines remotely....", abstract.

Pentel describes a remote ordering device for placing orders. There is no obvious indication in the Pentel patent that indicates the Pentel invention "discloses a method of accessing classification information on a web-based system...". The Pentel system consists of a data input and transmitting device (remote ordering device: cell phone, PDA, PC with cell phone) and an ordering (receiving) station for receiving data [column 2, lines 14-30]. Throughout the Pentel patent there is no mention of the receiving (ordering) station serving up web pages to a user or the user browsing a web site to remotely order using the remote ordering device. Pentel's describes a remote ordering device that provides a means for users (customers, servers, etc.) to transmit orders to a receiving station by transmitting 'data information' provided by the business establishment. The 'data information' can be provided to the user via the World Wide Web (businesses web site that provides order codes) [column 3, lines 13-20], programmed menus [column 3, lines 21-24 and column 1, lines 51-64], downloaded menus [column 3, lines 21-24], catalogs [column 3, line 24], posted at the establishment [column 3, lines 24-27], voice menus [column 3, lines 27-29], or a drive through display window [Fig1a]. This 'data information' is entered into the remote ordering device that can then be transmitted to the receiving station. Column 4 lines 16-33 provides other uses for Pentel, none of which indicates a web-based system. Also, an examination of the Pentel figures (Fig 1-15) and the accompanying detailed description do not reveal any indication that the Pentel invention is web-based. The detailed description of the Figures does not indicate that a web server is serving up web pages or the user is using a browser to select data.

The examiner references Column 10, lines 10-17 as proof that the Pentel patent "discloses a method of accessing classification information on a web-based system...". Column 10, lines 10-17 fails to support that Pentel is a web-based system because there is no mention of a web server, web pages, or a browser. Column 10, line 17 states "blue tooth or any other protocol" where the Internet Protocol (IP) could be one of the 'any other' protocols. The mere mention of IP is not enough to deduce a Web-based system

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without the mention of web server, web pages, and a browser. Therefore, one of ordinary skill in the art when looking at Pentel [column 10, lines 10-17] would not deduce that Pentel is a web-based system.

The examiner references Column 3, lines 30-53 as proof that "the Pentel invention connects to a remote web site...". Column 3, lines 30-53 fails to support that the Pentel invention connects to a remote Web site.

Column 3, lines 30-47 discusses how an item or service can be remotely ordered over a cell phone or other telecommunication link by dialing ONE number. The user dials the number and places an order over the telecommunication link then transfers the order to the desired business via the numbered dialed, over an internet link, or by forwarding the call. There is no indication that a Web site has been accessed. The mention of establishing an Internet link does not constitute a Web site, what it constitutes here is a **method of transport** for the user to transfer a restaurant type order, which has nothing to do with the features claimed in the subject invention.

Column 3, lines 47-53 of Pentel describes the use of a two-way communication device where menus are provided that allows the user to enter selections from a catalog, a restaurant menu, or tickets and seating for various venues. Column 3, lines 47-53 describes another means for a customer to indicate a desired establishment to order from, the same as is provided by dialing ONE number [column 3, lines 30-47]. Therefore, there is no indication that a Web site has been accessed using a two-way communication device which is clearly done with the "telephone" connected devices claimed in the subject invention.

The examiner references column 1, line 66 to column 2, line 5 to state that "it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Showghi to have included the teachings of Pentel because there is a need for a generalized remote ordering device for customer use...". Column 1, line 66 to column 2, line 5 discusses the need for a generalized remote ordering device which in the context of Pentel is referring to the handheld device [column 2, lines 1-3] of the Pentel invention. Again, Pentel is not a web-based system therefore the scope of the instant invention cannot be met by modifying Showghi to include the teachings of Pentel.

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The Pentel patent refers to using the World Wide Web (WWW) substantially different from that claimed in the subject claims. The following are the applications discussed in the Pentel patent referring to the WWW:

1. Service facility (store, restaurant etc.) provides order codes on the WWW for the user to enter into the input device after entering the service facility (store, restaurant etc.) [column 8, lines 6-13],
2. Service facility provides bar codes on the WWW for the user to scan into the input device (via scanner) after entering the service facility (store, restaurant etc.) [column 9, lines 22-35],
3. If a user places an order on Service facilities Web site when the User enters the facility the users input device signals the ordering station that the user has entered the facility to pick up the order. [column 9, lines 49-54]

Since Pentel is not a web-based system and Showghi is not a web-based system (as stated by the patent examiner), applicant respectfully requests removal of the rejection based on these references.

Claim 6 was rejected under sec. 103 as being unpatentable over Showghi in view of Pentel and further in view of Bidz, Ref. U. The Bidz reference does NOT overcome the deficiencies to BOTH Showghi and Pentel discussed above.

The Bidz reference does not overcome the deficiencies to Showghi. As noted in previous responses applicants' claim using a "personally owned handheld display device" for "accessing the web... through the handheld display device that is selected from at least one of a pager, a cell phone, and a PDA(personal digital assistant)...." Which are clearly claimed features NOT DESCRIBED, TAUGHT OR SUGGESTED BY BIDZ.

Clearly, Bidz does not describe, teach or suggest other claimed features of using the handheld display device so that the user reaches a "single vertical column of an finite selection list menu" and "viewing the single column of the finite selection list of the classification by scrolling down the finite selection list on the handheld display device, without the inputting of any search queries..." Clearly, as admitted by the examiner, these features are not described, taught or suggested by Bidz. Therefore removal of the Bidz reference is respectfully requested.

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In addition to the deficiencies referenced above with the other references, Bidz reference does NOT describe, teach or suggest a "remote web site having different advertisements from different sellers" as claimed in all the subject claims. Bidz requires an "auction" based service where users can "BID" on the items listed as is clearly suggest by the name of the site which is www.bidz.com. Applicants' claimed invention does not directly or indirectly require the making of "bids" and "auctions" as is required by this reference.

Applicant further disagrees with the characterization that the "plurality of headings" in the subject claims "would have been an obvious matter of design choice" and applicant has "not persuasively demonstrated the criticality of providing these specific headings ...." Applicant respectfully disagrees. Applicants' claimed category headings and "subcategory headings" are important claimed features that are described throughout the subject application and are clearly shown repeatedly in many of the subject invention drawing figures. For example, clearly, the Bidz reference does NOT describe teach or suggest the subject claims "subcategory" listing of "models, items and services" which is claimed in at least claims 7, and 32-35. Thus, removal of the Bidz reference is respectfully requested.

Claims 16 and 24 were rejected under sec. 103 as being unpatentable over Showghi in view of Pentel and further in view of Wolfe. The Wolfe reference does not overcome the deficiencies to Showghi or Pentel described above. The Wolfe reference does NOT describe, teach or suggest the claimed "remote website remote web site having different advertisements from different sellers" as is required by the claims or the other claimed features referenced above. In addition to the deficiencies previously noted there is NO instant notification in Wolfe for BOTH "good(s) and service(s)" as claimed in at least subject claims 24 and 31 of the subject invention.

In addition, applicant notes that this reference is NOT available prior art under sec. 102b since it was filed less than one year before the filing date of the provisional application of which this subject invention claims the benefit of priority from.

There is no teaching, nor suggestion for modifying the references of record to include all the novel features of the amended claims. Under well recognized rules of the

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MPEP (for example, section 706.02(j)), the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). The rejections of record do NOT establish a *prima facie* case of obviousness.

Based on the law, the initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). The references of record do not provide support for the conclusion that the subject claimed invention is obvious.

Where a reference is relied on to support a rejection, whether or not in a minor capacity, that reference should be positively included in the statement of the rejection. See *In re Hoch*, 428 F.2d 1341, 1342 n.3 166 USPQ 406, 407 n. 3 (CCPA 1970). Clearly, the references of record do not describe, teach or suggest all the features of the claimed invention.

The mere fact that someone in the art can rearrange parts of a reference device to meet the terms of a claim is not by itself sufficient to support a finding of obviousness. The prior art must provide a motivation or reason for someone of ordinary skill in the art,

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without the benefit of the inventor's specification to make the necessary changes in the reference device. *Ex parte Chicago Rawhide Mfg. Co.*, 223 USPQ 351, 353 (Bd. Pat. App. & Inter. 1984).

Again, there is no teaching, nor suggestion for modifying the references of record to include all the novel features of the amended claims. Under well recognized rules of the MPEP (for example, section 706.02(j)), the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438(Fed. Cir. 1991).

Applicant contends the references cannot be modified to incorporate the features of subject claims without utilizing Applicant's disclosure. The courts have consistently held that obviousness cannot be established by combining the teachings of the prior art to Applicant to produce the claimed invention, absent some teaching, suggestion, incentive or motivation supporting the combination.

It is respectfully urged that claims 1, 2, 6-9, 12-14, 16 and 23-35 be allowed. Such action is respectfully requested. If the Examiner believes that an interview would be helpful, the Examiner is requested to contact the attorney below.

Respectfully Submitted;



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